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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/706,142

11/12/2003

Roger W. Phillips

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07/10/2007

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EXAMINER

VARGOT, MATHIEU D

ART UNIT

PAPER NUMBER

1732

MAIL DATE

DELIVERY MODE

07/10/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/706,142

Applicant(s)

PHILLIPS ET AL.

Examiner

Mathieu D. Vargot

Art Unit

1732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 4/28/06.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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1.The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uyama et al for reasons of record as set forth in the previous actions.

2.Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uyama et al in view of Coombs et al –530 for reasons of record.

3.Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uyama et al in view of the admitted prior art for reasons of record.

4.Applicant's arguments filed May 1, 2007 have been fully considered but they are not persuasive. The package sent by Mr. Stewart containing the exhibits and declarations was received at the examiner's house in Owings, Maryland and will be made part of the record. Upon reviewing the exhibits, it is agreed that there is **some visual** difference with some of the exhibits, the difference being the intensity or brightness of the hologram. In the inventive examples, it was generally less than that of the prior art, where the coating is on the same side as the hologram (embossing). However, the difference is not considered to be significant enough to warrant patentability for at least two reasons. First of all, the difference is not that marked in Exhibit 2, 3 and 4, and hardly noticeable in Exhibit 6--it is greatest in Exhibit 5. However, the difference is not consistently noticeable in all examples. Ie, the difference is in degree, not kind, and hence does not rise to the level of something unexpected.

While applicant has indicated that the examiner believed there should be no difference—and hence any difference would be unexpected—such is not convincing. Obviously, the examiner has not the ability to test different methods and products made therefrom. Let's say, **it would have appeared to have made no difference**, when in fact there **is some difference**. However, it is respectfully submitted that this difference does not rise to the level of invention—because—secondly-- the difference is really dependent on what angle the hologram is looked at and to some extent, what lighting is present. Certainly, at different angles, there is hardly any difference in the holograms. Only Exhibit 5 shows a marked difference, where the inventive hologram is barely visible. However, the prior art hologram is also less visible in Exhibit 5. While the wine glass exhibits (Nos 3 and 6) do appear to be inverted—ie, the more visible glass in the inventive exhibit is the upside down one, while the more visible in the prior art is the right side up glass—this manifests itself only when looking directly at the sheets. When the sheets are viewed at an angle, such is not always the case. Hence, it would appear that the difference in effect is somewhat dependent on figure used in the hologram and certainly on angle viewed. Mr. Roger's declaration is summed up by saying that there is a "subtle but significant difference in the appearance" of the inventive and prior art Exhibits. Further, that "these subtle differences" would "provide a required difference in the field of security coatings." It is certainly agreed with that the inventive exhibits are different from those of the prior art in a "subtle" way—at least when looked at straight on (again, at angles, the differences are not so marked). However, there certainly is no showing that these differences, be they subtle or not, would provide any unexpected

benefit in the field of security coatings. If the aim is to make the hologram visible when looked upon at a 90 degree angle, then the instant process is actually worse than that of the prior art. At different angles, there does not appear to be any difference at all. It has never been argued or been made of record that the aim of the instant invention is to make the holograms less visible when looked directly at. In fact, it is not clear that such would even necessarily be a goal or a desired difference in the security art. Indeed, most items with holograms are looked at from an angle, not straight on. Given that the differences appear to be hologram and angle dependent, the instant declarations are not probative.

5.THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

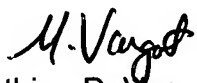
6.Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mathieu D. Vargot whose telephone number is 571 272-1211. The examiner can normally be reached on Mon-Fri from 9 to 6.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson, can be reached on 571 272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. Vargot
July 5, 2007


Mathieu D. Vargot
Primary Examiner
Art Unit 1732

7/5/07